

Appl. No. 10/751,132
Amdt. Dated 04/24/2006
Reply to Office Action of 03/23/2006

REMARKS

This is in response to the Office Action mailed 03/23/2005. In the Office Action, claims 1-43 were cited as being subject to restriction requirements. Reexamination and reconsideration of this case is respectfully requested in view of the amendments made herein and the following remarks.

Claims 12, 14-16, 23-26, and 29-30 have been amended. No claim has been canceled. New dependent claims 44-49 have been added. Accordingly, claims 1-49 are now at issue in the patent application. Of those at issue, claims 1, 12, 23, and 33 are independent claims. Applicant believes that no new matter has been added by this response.

I) First Restriction Requirement

On page 2 of the Office Action, claims 1-43 were made subject to a first restriction requirement under 35 USC 121 based on search classification. Claims 1-43 were restricted to the following three groups of claims:

I Claims 1-11, 33-39 and 41-43, drawn to an apparatus, classified in class 324, subclass 763.

II. Claims 12-22 and 40, drawn to apparatus, classified in class 324, subclass 763.

III Claims 23-32, drawn to method, classified in class 324, subclass 763.

In response, Applicant provisionally elects to go forward with claims 1-11, 33-39, and 41-43 of Invention I classified in class 324, subclass 763 as it has the largest number of claims paid for and respectfully traverses the first restriction requirement for the following reasons.

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On page 2, the Office Action states "Inventions I and II in a first set and III in a second set are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used by a materially different process that does not require the use of a ring oscillator and at least claims 1 and 33 serve as evidence that such is the case."

The Office Action further states on pages 3-4 that "Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require ring oscillators and at least claims 1 and 33 serve as evidence that such is the case. The subcombination has separate utility by itself that requires the use of a constantly powered ring oscillator.

Applicant has amended independent claim 23 to recite reliability oscillators, commensurate with independent claims 1 and 33. The further limitation of a ring oscillator has been moved into new dependent claims 48-49. Applicant respectfully submits that the reason for separate examination of claims in Invention I and II from claims in Invention III is now moot.

Moreover, as recited in Applicant's specification for example, "[t]he reliability oscillator 400 includes an odd number of inverters connected in series to provide a ring oscillator." [Specification, Page 12, lines 4-6].

Applicant has also amended independent claim 12 to remove the limitation of "constantly". Applicant respectfully submits that the reason for separate examination of claims in Invention I from claims in Invention II is now moot.

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Additionally, each of the Inventions I, II, and III have been designated to be in the same search class and subclass, class 324, subclass 763. Thus, there should not be a serious search burden. See MPEP 806.05(c).

Applicant respectfully requests reconsideration of the distinctness between Inventions I and II in the first set and Invention III in the second set and the requirement for separate examination of each set.

For the foregoing reasons, Applicant respectfully request reconsideration of this restriction requirement.

II) Second Restriction Requirement

On page 4 of the Office Action, claims 1-43 were further made subject to a second restriction requirement under 35 USC 121 based on species. Claims 1-43 were restricted to four species.

The Office Actions states "This application contains claims directed to the following patentably distinct species:

- (a) The species detailed in Applicant's specification at page 5, lines 6-17;
- (b) The species detailed in Applicant's specification at page 5, line 18 - page 6, line 5;
- (c) The species detailed in Applicant's specification at page 6, lines 6-16;
- (d) The species detailed in Applicant's specification at page 6, lines 17-32."

In response, Applicant provisionally elects to go forward with species (a) and respectfully traverses the second restriction requirement for the following reasons.

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The embodiments described on Applicant's specification from page 5, line 6 through page 6, line 32 were based on Applicant's claims as filed. Applicant has since amended the claims such that these embodiments described in the specification may not accurately represent what is currently claimed.

The Office Action did not restrict the species to respective figures as is ordinarily the case. Accordingly, it is difficult to determine what claims read on the species. Thus, Applicant respectfully submits that Claims 1-49 read on Species (a).

The Office Action states "Currently, no claim appears to be generic." Applicant respectfully disagrees. Applicant respectfully submits that at least independent claims 1, 12, 23, and 33 are generic.

For the foregoing reasons, Applicant respectfully request reconsideration of this restriction requirement.

III) Claim Amendments

Applicant has amended claims 12, 14-16, 23-26, and 29-30.

Applicant has amended claims 12, 14-16, 23-26, and 29-30 to make the restriction requirement moot.

As claims 1-43 have yet to be substantively examined, Applicant respectfully submits that these claim amendments have not been made for reasons related to patentability.

IV) New Claims

As previously discussed, Applicant has added dependent claims 44-49. Applicant respectfully submits that these claims can also be examined with claims 1-43 for the reasons provided above.

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CONCLUSION

A first examination as to the merits of claims 1-49 is respectfully requested. Allowance of the claims at an early date is solicited.

The Examiner is invited to contact Applicant's undersigned counsel by telephone at (714) 557-3800 to expedite the prosecution of this case should there be any unresolved matters remaining. To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such deposit account.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: April 24, 2006

By


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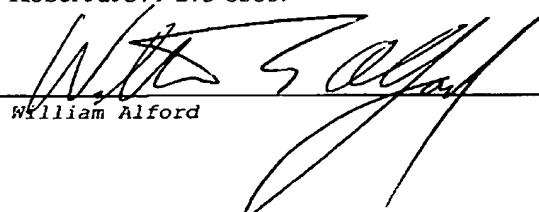
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted via facsimile to the Patent and Trademark Office under 37 CFR §1.8 on: April 24, 2006 to Examiner Kobert at 571-273-8300.


William Alford

4/24/06

Date